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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/544,084	04/06/2000	Asgeir Saebo	CONLINCO-04286	7973

23535 7590 02/11/2004

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EXAMINER	
WANG, SHENGJUN	
ART UNIT	**PAPER NUMBER**
1617	

DATE MAILED: 02/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/544,084	SAEBO ET AL.	
	Examiner	Art Unit	
	Shengjun Wang	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 November 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18 and 31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18 and 31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date May 30, 2003
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Receipt of applicants' amendments and remarks submitted November 24, 2003 is acknowledged.

Double Patenting Rejections

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-18 and 31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-16 of U.S. Patent No. 6,015,833 in view of Cook et al. (U.S. 5,760,082) for reasons set forth in the prior office action.

Claim Rejections 35 U.S.C. §103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-18 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook et al. (U.S. Patent 5,760,082 of record) in view of Cain et al. (WO 97/18320, IDS 35) and Baltes et al. (U.S. Patent 3,162,658, of record) for reasons set forth in the prior office action.

Claim Rejections 35 U.S.C. §103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-18 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook et al. (U.S. Patent 5,760,082 of record) in view of Cain et al. (WO 97/18320, IDS 35) and Baltes et al. (U.S. Patent 3,162,658, of record).

7. Cook teaches a food product containing conjugated linoleic acids, their esters, salts or mixtures. The linoleic acid compounds may be from corn oil, safflower etc. the food products may further containing vitamins. The conjugated linoleic acid may be in the forms of free acid, non toxic salt or esters, such as triglycerides. See, particularly, the abstract, column 1, lines 10-13, lines 49-60. Column 2, lines 51-67, Examples 2- 5. Cook teaches that employment of alkali catalyst for making conjugated linoleic acid moiety for linoleic acid moiety is known. See, particularly, example 1, in column 2. Cook further teaches that conjugated linoleic acid may be incorporated into various food products. See column 5, lines 6-14.

8. Cook does not teach expressly to employ alcoholic catalyst for isomerization of linoleic acid to obtain CLA, or to employ antioxidants such as vitamin E in the food products or the conjugated linoleic acid compounds are produced by the method herein, e.g., treating linoleic

acid with potassium methylate, or particularly reduce the volatile organic compounds to the level of 5 ppm.

9. However, Cain et al. teaches that it is well-known in the art that antioxidants, such as vitamin E or BHT, is known to be useful in food product containing conjugated linoleic acid compounds, e.g., conjugated linoleic acid ester. See, particularly, page 6, lines 29-36, the examples 1-20 and the claims. Cook teaches that any solvent in CLA should be removed under vacuum, and CLA is stored in a condition no oxidation would happen (under Argon, in dark and low temperature) before the CLA could be used in food product. See, particularly, column 2, lines 40-47. Baltes teach that isomerization of linoleic acid compounds to conjugated linoleic acid compounds by alcoholate catalysts, such as potassium methylate is well known. See, particularly, the examples 2-4 and the claims. The employment of alkali monohydric alcoholate has advantage that isomerization is possible without using more than stoimetrical amounts of alkali metal alcoholate. See column 2, lines 31-35.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to employ alcoholate catalyst, such as potassium methylate, for isomerization of linoleic acid to obtain CLA, or to incorporate conjugated linoleic acid derivatives, including esters, as well as antioxidant in a food product, wherein the CLA is free of volatile organic compounds and free of oxidation.

A person of ordinary skill in the art would have been motivated to employ alcoholate catalyst, such as potassium methylate, for isomerization of linoleic acid to obtain CLA, or to incorporate conjugated linoleic acid derivatives, including esters, as well as antioxidants in a food product, wherein the CLA is free of volatile organic compounds and free of oxidation

because alcoholate catalysts, such as potassium methylate, are well-known to be useful for isomerization of linoleic acid to CLA, and CLA is known to be sensitive to oxidation and antioxidant are known to be useful along with conjugated linoleic acid compounds in food products. Regarding the limitation about the method to obtain the conjugated linoleic acid, note a method of making ingredients is not seen to render patentable weight to a method which employs such ingredients, absent evidence to the contrary. It is particularly truth if the method of making the ingredients is a well-known process, e.g., employ alkali monohydric alcoholate for making conjugated linoleic acid. A process of making a composition by simply combining or mixing the known ingredients is seen to be within the skill of the artisan. Further, purifying CLA composition by using silica gel (adsorbent) is seen to be obvious since silica gel is well known for purification and separation purpose. Having a limitation of the volatile organic compound (VOC) in food product (whether it is the limitation after storage or before storage) is considered an optimization of a result effective parameter, which is considered within the skill of the artisan. See, In re Boesch and Slaney (CCPA) 204 USPQ 215.

Response to the Arguments

Applicants' amendments and remarks submitted November 24, 2003 have been fully considered, but are not persuasive for reasons discussed below.

Applicants assert that the examiner make a conclusive statement because "it merely recites the references and says that they can be combined to produce the claimed results because the individual elements are "well-known."" The examiner disagrees. The "well-known" conclusion is supported by the teaching of Baltes et al. Cain et al. The instant claims are drawn to a method of making CLA and using the CLA in food product. If the method of making CLA

herein claimed is well-known, and using CLA in food product is well-known, the claimed method would have bee n obvious.

10. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). As to Baltes' teaching, the examiner restates that Baltes reference does not expressly limited to produce CLA for coating. Note question under 35 U.S.C. 103 is not merely what reference expressly teach, but what they would have suggested to one of ordinary skill in the art at the time the invention was made; all disclosures of prior art, including unpreferred embodiments, must considered. In re Lamberti and Konort (CCPA), 192 USPQ 278. Contrary to applicants' assertion, Baltes state "The invention relates to a process for substantially complete catalytic conversion of compounds of unconjugated polyethenoid acid into compounds of conjugated enthenoid acid." (column 1, lines 13-16). " It will be appreciated from the above that this invention is not limited to the materials, steps, conditions and other details specifically described above and can be carried out with various modification. Thus, it will be understood that the process of this invention is broadly applicable to **any unconjugated polyethenoid acid compounds and products containing them**." (column 8, lines 20-50, examiner emphasis added). Baltes particularly claims the process for the catalytic isomerization of unconjugated polyethenoid fatty acid compounds to conjugated isomers using alkali metal monohydric

alcoholate (see, particularly, claim 10-12). Dr. Sabo's declaration is not persuasive as stated in the office action mailed December 28, 2001.

11. The examiner inadvertently omitted claim 31 in last office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (571)272-0632 after February 3, 2004). The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Primary Examiner

Shengjun Wang

February 6, 2004